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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/997,504	11/19/2001	Michael E. Himmel	NREL 99-38	3921

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EXAMINER

RAO, MANJUNATH N

ART UNIT	PAPER NUMBER
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1652

DATE MAILED: 01/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/997,504

Applicant(s)

HIMMEL ET AL.

Examiner

Manjunath N. Rao, Ph.D.

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 05 January 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See attached. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 3, 7, 29, 31.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☐ Other: _____.

Manjunath N. Rao, Ph.D.
Primary Examiner
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Advisory Action

Claims 3, 7, 29, 31 are now currently pending in this application.

Applicant's amendment filed on 1-5-06 after the final rejection has been considered but NOT ENTERED, as it raises new issues and requires the Examiner to institute new search and rejections that may arise after the new search. The amendment has not been entered for the following reasons;

In response to the previous Final Rejection in which claims recited polynucleotide sequences without any SEQ ID NOs, applicants have now filed claims reciting polypeptide sequences with SEQ ID NO:2, 3 and 4. Amending the claims to include the new SEQ ID NOs at this stage during the prosecution requires the Examiner to do a new search.

A perusal of the prosecution history of this application indicates that applicants have frequently gone back and forth with respect to the SEQ ID NO recited in the claims with constant notice from the Examiner that he has not been able to do a meaningful search. Applicants had indeed included SEQ ID NO:2, 3 and 4 in claims earlier. However, they changed the sequences in a supplemental amendment to SEQ ID NO:10, 12 and 14 which was searched by the Examiner. In later amendments, applicants changed the polypeptide sequences SEQ ID NO:10, 12 and 14 to polynucleotide sequences without any SEQ ID NO and now in the instant amendment, applicants have changed the sequences back to polypeptide with SEQ ID NO:2,3 and 4.

Even when one considers the instant RCE application currently under prosecution which was filed on 4-18-05, claims 7 and 31 first recited SEQ ID NO:2, 3, and 4. However, these SEQ ID NO belonged to short oligonucleotide sequences in the sequence listing and this discrepancy

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was brought to the attention of the applicant in the Office action mailed on 6-29-05. In response, applicants filed an amendment on 8-15-05 in which claims 7 and 31 recited extremely long polynucleotide sequences without any SEQ ID NOs while the claims were actually drawn to a method of modifying a specific polypeptide sequence at specific amino acid positions.

Examiner mailed an Office action (the Final rejection) on 10-28-05 again bringing the attention of the applicant to the sequence discrepancy fully apprising the applicant that a meaningful search could not be done. Now in response to that Final rejection of 10-28-05 applicants have again amended the claim by introducing polypeptide sequences labeled as SEQ ID NO:2, 3 and 4. This amendment cannot be entered by the Examiner mainly for two reasons. First, changing the sequences from a polynucleotide to polypeptide sequences raises new issues and second, SEQ ID NO:2, 3 and 4 continue to be depicted as short oligonucleotide sequences in the sequence listing and therefore a meaningful search cannot be made even if the Examiner wants to do a search.

In their remarks, applicants make vague comments such as “exceptionally formalistic rejections”, “exceptionally large number of formal rejections” etc. However, with all due respects, such rejections needed to be made in view of the applicant’s frequent flip-flopping regarding the sequences and exceptionally large number of sequence errors. Applicants also comment that no prior art rejections have been made and the Examiner is continuing to make rejections under 35 U.S.C. 112 statutes. Again with all due respects, Examiner has simply followed rules and when applicant continues to make errors regarding sequences, Examiner has to address those issues and that is what he has done even now. Furthermore, it cannot be

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declared that the invention is free of prior art until applicants provide the correct SEQ ID NO and the Examiner is able to do a meaningful search.

Applicants have not filed any amended sequence listing after 5-24-04. Examiner has not searched any other sequences except for SEQ ID NO:10, 12, 14 which were the sequences that indicated in the very beginning of the prosecution. Even in this instant response to the Final Rejection, applicants have traversed the rejections of claims 7, 29 and 31 as indefinite under 35 U.S.C. 112, 2nd paragraph, arguing that claim 7 and 31 now recite the specific amino acid sequences or that in view of the amendments it is now clear as to which specific amino acids are mutated etc., without even checking that indeed their SEQ ID NO:2, 3 and 4 are short oligonucleotide sequences.

In view of all the above, Examiner regrets that he is unable to enter the amendment filed on 1-5-06. In view of the non-entry of the above amendment, all previous rejections are hereby maintained for reasons of record.

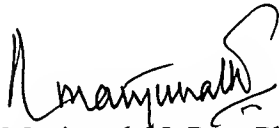
Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Manjunath N. Rao, Ph.D. whose telephone number is 571-272-0939. The Examiner can normally be reached on 7.00 a.m. to 3.30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Ponnathapura Achutamurthy can be reached on 571-272-0928. The fax phone numbers for the organization where this application or proceeding is assigned is 571-273-8300 for regular communications and for After Final communications. Any inquiry of a general nature or relating to the status of

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this application or proceeding should be directed to the receptionist whose telephone number is
571-272-1600.

A handwritten signature in black ink, appearing to read 'Manjunath', with a stylized flourish at the end.

Manjunath N. Rao, Ph.D.
Primary Examiner
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January 18, 2006